

10/089359

Practitioner's Docket No. U013949-3

CHAPTER II

## IN THE UNITED STATES ELECTED OFFICE (EO/US)

PCT/AU00/01166	26 SEPTEMBER 2000	27 SEPTEMBER 1999
INTERNATIONAL APPLICATION NO.	INTERNATIONAL FILING DATE	PRIORITY DATE CLAIMED

A MOUTHGUARD  
TITLE OF INVENTION

PETER BURNS  
APPLICANT(S)

Box PCT  
Assistant Commissioner for Patents  
Washington, D.C. 20231  
ATTENTION: EO/US

**COMPLETION OF FILING REQUIREMENTS  
FOR INTERNATIONAL APPLICATION ENTERING U.S. NATIONAL STAGE  
IN U.S. ELECTED OFFICE (EO/US) UNDER 35 U.S.C. § 371**

*(check and complete the applicable item, if applicable)*

- [x] This replies to the Notice of Missing Requirements under 35 U.S.C. § 371 and 37 C.F.R. § 1.495 (FORM PCT/DO/EO/905).  
[x] A copy of FORM PCT/DO/EO/905 accompanies this response.

**WARNING:** *Where the items being submitted to complete the entry of the international application into the national phase are subsequent to 30 months from the priority date the application is still considered to be in the international state and if mailing procedures are utilized to obtain a date the express mail procedure of 37 C.F.R. § 1.10 must be used (because international application papers are not covered by an ordinary certificate of mailing. 37 C.F.R. § 108(2)(xi).*

**CERTIFICATION UNDER 37 C.F.R. 1.10\***  
*(Express Mail label number is mandatory.)  
(Express Mail certification is optional.)*

I hereby certify that this Completion of Filing Requirements and the papers indicated as being transmitted therewith are being deposited with the United States Postal Service on this date June 10, 2002, in an envelope as "Express Mail Post Office to Addressee," Mailing Label Number EV011022470US, addressed to the Assistant Commissioner for Patents, Washington, D.C. 20231.

CONNIE YANNOTTI  
*(type or print name of person mailing paper)*

*Connie Yannotti*  
Signature of person mailing paper

**WARNING:** *Certificate of mailing (first class) or facsimile transmission procedures of 37 C.F.R. 1.8 cannot be used to obtain a date of mailing or transmission for this correspondence.*

**\*WARNING:** *Each paper or fee filed by "Express Mail" must have the number of the "Express Mail" mailing label placed thereon prior to mailing. 37 C.F.R. 1.10(b).  
"Since the filing of correspondence under § 1.10 without the Express Mail mailing label thereon is an oversight that can be avoided by the exercise of reasonable care, requests for waiver of this requirement will not be granted on petition." Notice of Oct. 24, 1996, 60 Fed. Reg. 56,439, at 56,442.*

(Completion of Filing Requirements for International Application Entering U.S. Elected Office (EO/US))

**NOTE:** Documents and fees must be clearly identified as a submission to enter the national stage under 35 U.S.C. § 371. Otherwise, the submission will be considered as being made under 35 U.S.C. § 111. 37 C.F.R. § 1.495(g).

## DECLARATION OR OATH

**NOTE:** 37 C.F.R. § 1.495(c): "If applicant complies with paragraph (b) of this section before expiration of thirty months from the priority date but omits . . . the oath or declaration of the inventor (35 U.S.C. 371(c)(4) and § 1.497), if a declaration of inventorship in compliance with § 1.497 has not been previously submitted in the international application under PCT Rule 4.17 (iv) within the time limits provided for in PCT Rule 26ter.1, applicant will be so notified and given a period of time within which to file the . . . oath or declaration in order to prevent abandonment of the application . . . . The payment of the surcharge set forth in § 1.492(e) is required for acceptance of the oath or declaration of the inventor later than the expiration of thirty months after the priority date."

I. (a) ☒ No original declaration or oath was filed. Enclosed is the original declaration or oath for this application.

OR

(b) ☐ The declaration or oath that was filed was determined to be defective. A new original oath or declaration is attached.

**NOTE:** For surcharge fee for filing declaration after filing date complete item IV(3)

**NOTE:** **NOTE:** Acceptable minimums in the declaration in an ordinarily filed U.S. application for identification of the specification to which it applies are:

- (A) application number (consisting of the series code and the serial number, e.g., 08/123,456);
- (B) serial number and filing date;
- (C) attorney docket number which was on the specification as filed;
- (D) title which was on the specification as filed and reference to an attached specification which is both attached to the oath or declaration at the time of execution and submitted with the oath or declaration; or
- (E) title which was on the specification as filed and accompanied by a cover letter accurately identifying the application for which it was intended by either the application number (consisting of the series code and the serial number, e.g., 08/123,456), or serial number and filing date. Absent any statement(s) to the contrary, it will be presumed that the application filed in the PTO is the application which the inventor(s) executed by signing the oath or declaration.  
M.P.E.P. Section 601.01(a), 7th ed. Notice of September 12, 1983 (1035 O.G. 3). See MPEP § 601.01(a), 7<sup>th</sup> ed.

**NOTE:** Another minimum found acceptable in the declaration is the filing date (i.e., date of express mail) and the express mail number, useful where the serial number is not yet known. But note the practice where the express mail deposit is a Saturday, Sunday or holiday within the District of Columbia. 37 C.F.R. § 1.10(c).

**NOTE:** See 37 C.F.R. § 1.41(a).

(complete as applicable)

Attached is a

- (c) ☐ Statement by a registered attorney that the application filed in the PTO is the application that the inventor executed by signing the declaration.
- (d) ☐ Statement that the "attached" specification is a copy of the specification and any amendments thereto that were filed in the PTO to obtain the filing date.
- (e) ☐ Statement that substitute specification contains no new matter.
- (f) ☐ Preliminary Amendment
- (g) ☐ Transmittal of Formal Drawing(s) Prior to Notice of Allowance
- (h) ☐ Submission of "Sequence Listing," computer readable copy, and/or amendment pertaining thereto for biotechnology invention containing nucleotide and/or amino acid sequence

#### AMENDMENT

#### II. *(complete as applicable)*

- ☐ An amendment in accordance with 37 C.F.R. § 1.121 is attached.
- ☐ The attached amendment cancels claims \_\_\_\_\_ inclusive.

#### TRANSMITTAL OF ENGLISH TRANSLATION OF NON-ENGLISH LANGUAGE PAPERS

- III. ☐ Submitted herewith is an English translation of the non-English language international application papers as originally filed. It is requested that this translation be used as the copy for examination purposes in the PTO. (See 37 C.F.R. 1.495(c))

NOTE: *For fee for processing a non-English application, complete item IV(4).*

NOTE: *A non-English oath or declaration in the form provided or approved by the PTO need not be translated. 37 C.F.R. § 1.69(b).*

#### FEES

#### IV.

NOTE: *See 37 C.F.R. § 1.28(a).*

##### 1. Fees for claims

- ☐ each independent claim in excess of 3  
(37 C.F.R. § 1.492(b))—\$84.00; small entity—\$42.00 \$ \_\_\_\_\_
- ☐ each claim in excess of 20  
(37 C.F.R. § 1.492(c))—\$18.00; small entity—\$9.00 \$ \_\_\_\_\_
- ☐ multiple dependent claims(s)  
(37 C.F.R. § 1.492(d))—\$280.00; small entity—\$140.00 \$ \_\_\_\_\_

2. Surcharge fees

☒ surcharge set forth in 37 C.F.R. § 1.492(e) for accepting the declaration later than 30 months after the priority date in filing an application in the U.S. as a designated office—\$130.00; small entity—\$65.00 \$ 65.00

NOTE: The processing fee in the next item 3 below is not subject to a reduction for small entity status.

3. ☐ processing fee set forth in 37 C.F.R. § 1.492(f) for acceptance of an English translation later than 30 months after the priority date—\$130.00 \$ \_\_\_\_\_

**Total Fees** \$ \_\_\_\_\_

**SMALL ENTITY STATUS**

V. a. ☒ A statement that this filing is by a small entity

NOTE: See 37 C.F.R. § 1.28(a).

(check and complete applicable items)

☒ is attached.  
☐ was filed on \_\_\_\_\_.  
☐ was made by paying the basic national fee as a small entity.

b. ☐ A separate refund request accompanies this paper.

**EXTENSION OF TIME**

(complete (a) or (b), as applicable)

**VI.**

The proceedings herein are for a patent application. Accordingly, the provisions of 37 C.F.R. § 1.136(a) apply.

(a) ☐ Applicant petitions for an extension of time, the fees for which are set out in 37 C.F.R. § 1.17(a)(1)-(4), for the total number of months checked out below:

Extension (months)	Fee for other than small entity	Fee for small entity
<input type="checkbox"/> one month	\$ 110.00	\$ 55.00
<input type="checkbox"/> two months	\$ 400.00	\$ 200.00
<input type="checkbox"/> three months	\$ 920.00	\$ 460.00
<input type="checkbox"/> four months	\$ 1,440.00	\$ 720.00
<input type="checkbox"/> five months	\$ 1,960.00	\$ 980.00

Fee: \$ \_\_\_\_\_

05/14/2002 SNAJARRO 00000059 10089359

01 FC:254

65.00 0P

If an additional extension of time is required, please consider this a petition therefor.

*(check and complete the next item, if applicable)*

- ☐ An extension for \_\_\_\_\_ months has already been secured. The fee paid therefor of \$ \_\_\_\_\_ is deducted from the total fee due for the total months of extension now requested.

Extension fee due with this request \$ \_\_\_\_\_

or

- (b) ☒ Applicant believes that no extension of term is required. However, this conditional petition is being made to provide for the possibility that applicant has inadvertently overlooked the need for a petition and fee for extension of time.

#### TOTAL FEE DUE

#### VII.

The total fee due is:

Completion fee(s) \$ 65.00

Extension fee (if any) \$ \_\_\_\_\_

TOTAL FEE DUE \$ \_\_\_\_\_

#### PAYMENT OF FEES

#### VIII.

- ☒ Enclosed is a check in the amount of \$ 65.00  
☐ Charge Account No. 12-0425 in the amount of \$ \_\_\_\_\_  
☐ A duplicate of this request is attached.

**NOTE:** Fees should be itemized in such a manner that it is clear for which purpose the fees are paid. 37 C.F.R. § 1.22(b).

#### AUTHORIZATION TO CHARGE ADDITIONAL FEES

#### IX.

**WARNING:** Accurately count claims, especially multiple dependent claims, to avoid unexpected high charges if extra claims are authorized.

**NOTE:** "A written request may be submitted in an application that is an authorization to treat any concurrent or future reply, requiring a petition for an extension of time under this paragraph for its timely submission, as incorporating a petition for extension of time for the appropriate length of time. An authorization to charge all required fees, fees under § 1.17, or all required extension of time fees will be treated as a constructive petition for an extension of time in any concurrent or future reply requiring a petition for an extension of time under this paragraph for its timely submission. Submission of the fee set forth in § 1.17(a) will also be treated as a constructive petition for an extension of time in any concurrent reply requiring a petition for an extension of time under this paragraph for its timely submission." 37 C.F.R. § 1.136(a)(3).

**NOTE:** "Amounts of twenty-five dollars or less will not be returned unless specifically requested within a reasonable time, nor will the payer be notified of such amounts; amounts over twenty-five dollars may be returned by check or, if requested, by credit to a deposit account." 37 C.F.R. § 1.26(a).

- ☒ The Commissioner is hereby authorized to charge the following additional fees that may  
(Completion of Filing Requirements for International Application Entering U.S. Elected Office (EO/US)

be required by this paper and during the entire pendency of this application to Account No. 12-0425

☒ 37 C.F.R. § 1.492(a)(1), 1.492(a)(4) (filing fees)

☐ 37 C.F.R. § 1.492(b), (c), and (d) (presentation of extra claims)

**NOTE:**

*Because additional fees for excess or multiple dependent claims not paid on filing or on later presentation must only be paid or these claims cancelled by amendment prior to the expiration of the time period set for response by the PTO in any notice of fee deficiency (37 C.F.R. § 1.16(d)), it might be best not to authorize the PTO to charge additional claim fees, except possibly when dealing with amendments after final action.*

☒ 37 C.F.R. § 1.17 (application processing fees)

☒ 37 C.F.R. § 1.17(a)(1)-(5)(extension fees pursuant to § 1.136(a)).

☒ 37 C.F.R. § 1.18 (issue fee at or before mailing of Notice of Allowance, pursuant to 37 C.F.R. § 1.311(b)).

**NOTE:**

*Where an authorization to charge the issue fee to a deposit account has been filed before the mailing of a Notice of Allowance, the issue fee will be automatically charged to the deposit account at the time of mailing the notice of allowance. 37 C.F.R. § 1.311(b).*

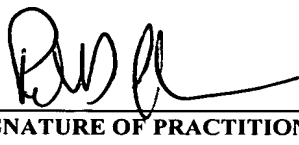
**NOTE:**

*37 C.F.R. § 1.28(b) requires "Notification of any change in loss of entitlement to small entity status must be filed in the application . . . prior to paying, or at the time of paying . . . issue fee." From the wording of 37 C.F.R. § 1.28(b): (a) notification of change of status must be made even if the fee is paid as "other than a small entity" and (b) no notification is required if the change is to another small entity.*

☐ 37 C.F.R. § 1.492(e) and/or (f) surcharge fees for filing the declaration and/or an English translation of an international application later than 30 months from the earliest-claimed priority date.

**WARNING:**

*It would be wise to always check this last authorization.*



SIGNATURE OF PRACTITIONER

Reg. No.: 27,885

PETER D. GALLOWAY

(type or print name of practitioner)

Tel. No.: (212)708-1905

P.O. Address

Customer No.: 00140

c/o Ladas & Parry  
26 West 61<sup>st</sup> Street  
New York, N.Y. 10023



UNITED STATES PATENT AND TRADEMARK OFFICE

 Commissioner for Patents, Box PCT  
 United States Patent and Trademark Office  
 Washington, D.C. 20231  
 www.uspto.gov

U.S. APPLICATION NUMBER NO.	FIRST NAMED APPLICANT	ATTY. DOCKET NO.
10/089,359	Peter Burns	U 013949-3

INTERNATIONAL APPLICATION NO.
-------------------------------

PCT/AU00/01166

I.A. FILING DATE	PRIORITY DATE
09/26/2000	09/27/1999

 00140  
 LADAS & PARRY  
 26 WEST 61ST STREET  
 NEW YORK, NY 10023
**RECEIVED**

JUN - 4 2002

**L. & P.**

CONFIRMATION NO. 7841

371 FORMALITIES LETTER



\*OC000000008190211\*

Date Mailed: 05/29/2002

### NOTIFICATION OF MISSING REQUIREMENTS UNDER 35 U.S.C. 371 IN THE UNITED STATES DESIGNATED/ELECTED OFFICE (DO/EO/US)

The following items have been submitted by the applicant or the IB to the United States Patent and Trademark Office as an Elected Office (37 CFR 1.495):

- U.S. Basic National Fees
- Priority Document
- Copy of IPE Report
- Copy of the International Application
- Copy of the International Search Report
- Request for Immediate Examination

The following items **MUST** be furnished within the period set forth below in order to complete the requirements for acceptance under 35 U.S.C. 371:

- Oath or declaration of the inventors, in compliance with 37 CFR 1.497(a) and (b), identifying the application by the International application number and international filing date.
- \$130 Surcharge for providing the oath or declaration later than the appropriate 30 months months from the priority date (37 CFR 1.492(e)) is required.

**ALL OF THE ITEMS SET FORTH ABOVE MUST BE SUBMITTED WITHIN TWO (2) MONTH FROM THE DATE OF THIS NOTICE OR BY 22 or 32 MONTHS (where 37 CFR 1.495 applies) FROM THE PRIORITY DATE FOR THE APPLICATION, WHICHEVER IS LATER. FAILURE TO PROPERLY RESPOND WILL RESULT IN ABANDONMENT.**

The time period set above may be extended by filing a petition and fee for extension of time under the provisions of 37 CFR 1.136(a).

SUMMARY OF FEES DUE:

Total additional fees required for this application is **\$130** for a Large Entity:

- **\$130** Late oath or declaration Surcharge.

Applicant is reminded that any communications to the United States Patent and Trademark Office must be mailed to the address given in the heading and include the U.S. application no. shown above (37 CFR 1.5)

*A copy of this notice **MUST** be returned with the response.*

WINSTON M ALVARADO

Telephone: (703) 305-6421

**PART 1 - ATTORNEY/APPLICANT COPY**

U.S. APPLICATION NUMBER NO.	INTERNATIONAL APPLICATION NO.	ATTY. DOCKET NO.
10/089,359	PCT/AU00/01166	U 013949-3

FORM PCT/DO/EO/905 (371 Formalities Notice)